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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,615	11/15/2000	Yuji Ayatsuka	112857-264	3858
29175	7590	06/14/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			POLLACK, MELVIN H	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/713,615	Applicant(s) AYATSUKA ET AL.	
	Examiner Melvin H. Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8,9,11,12,14,18-23,25-30 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,9,11,12,14,18-23,25-30 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. P-11-327670.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 April 2006 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3, 8, 9, 11, 12, 14, 18-23, 25-30 and 33-39 have been considered but are moot in view of the new ground(s) of rejection.

3. The examiner has modified the secondary art in favor of new art. Therefore, the original art rejections are withdrawn for this action.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. In response to applicant's argument that Slocum and Bansal do not expressly disclose certain features already shown to be disclosed by Emens, i.e. connecting to the imaged target, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

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teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 18-22 recite the limitation "said application means" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. None of the claims 18-22, nor claim 3, recite and describe an application means.

9. Claims 21 and 36 recite the limitation "the video recording appointment information input at said user terminal" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. Claims 3 and 23 do not recite a video recording appointment information, nor the inputting of such information.

10. Claim 38 recites the limitation "said application means transmits the video recording appointment information input at said user terminal to a target" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3, 8, 9, 11, 12, 14, 18, 19 - 21, 23, 25-30, 33, 34, and 36 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (6,463,343) in view of Kerchner (6,559,882).

13. For claim 1, Emens teaches a portable information processing terminal (abstract) adapted to be connected to one or more than one targets (col. 1, line 1 – col. 2, line 20) by way of a network (Fig. 1), said terminal comprising:

- a. An imaging means (Fig. 1, #116) for imaging visible identification information attached to the targets (col. 5, lines 55-65);
- b. An identification means (col. 5, lines 1-15) for identifying the targets on the basis of the identification information imaged by said imaging means (col. 5, line 65 – col. 6, line 15);
- c. A connection means (Fig. 3, #302) for automatically identifying a connection path (Fig. 3, #326) and establishing connection (Fig. 3, #322) between itself (Fig. 1, #104) and the targets identified by said identification means (Fig. 1, #120);
- d. An image display means (Fig. 2c) for displaying the images of the targets (col. 5, lines 15-45); and
- e. Said image display means displays status (Fig. 2F) of connection to the one or more than one targets (col. 6, lines 15-45).

14. For claims 3 and 23, Emens teaches (abstract) an information input/output method and system (col. 1, line 1 – col. 2, line 20) comprising:

- a. A user terminal to be used by a user (Fig. 1, #102);

- b. One or more than one targets (Fig. 1, #120) connected to said user terminal (Fig. 1, #104) in a format adapted to transfer of information and including visible identification information (col. 3, lines 30-50; col. 3, line 65 – col. 4, line 10);
 - c. An identification means for an identifying the targets on the basis of the identification information imaged (Fig. 3, #306), the identification information being attached to the targets by an imaging means (col. 4, lines 15-60); and
 - d. A connection means automatically identifying a connection path (Fig. 3, #326) for establishing connection between the user terminal and the targets identified by said identification means (col. 2, line 40 –col. 3, line 15);
 - e. Said user terminal includes a display screen (Fig. 1, #108); and
 - f. The images and status of connection to the one or more than one targets taken by said imaging means is displayed on said display screen (Fig. 2D and 2E).
15. For claims 1, 3, and 23, Emens does not expressly disclose identification means for automatically identifying the targets on the basis of the identification information imaged by said imaging means, nor the step of automatically identifying the targets, nor the step of establishing connection based on the imaged identification information. Kerchner teaches a method and system (abstract) of a kitchen appliance attached to a home network (col. 1, line 1 –col. 8, line 35), wherein a camera images information attached to the target and interprets the information to determine control of the target (col. 21, lines 10-35), i.e. determining operation of a microwave by using a camera and infrared sensors to determine how well food inside the microwave is being cooked or defrosted. Further, Kerchner teaches the addition of a barcode reader (col. 19, lines 64-65), and while its express purpose is to allow the unit to reorder items, such information

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could also be used to program a microwave when the item is inside, i.e. preselect times and power levels for popcorn (col. 6, lines 13-20). Such changes in operation are further automatically controlled by a remote PC, thus further indicating an establishing of connection, and therefore an inherent automatic identification of a connection path (col. 8, lines 1-5). At the time the invention was made, one of ordinary skill in the art would have added Kerchner's imaging to Emens in order to save energy and to avoid human error such as overheating of items (col. 6, lines 25-50).

16. For claims 8 and 25, Emens teaches that said user terminal is connected to said targets by way of a network (col. 3, lines 25-30), said targets have respective network addresses (col. 3, lines 33-38), said information input/output system further comprising a data base means for controlling the correspondence between the identification information of each target and its network address (col. 5, lines 20-22), and said connection means being adapted to connect the user terminal and the targets by referring to said data base means for the network address of each target corresponding to the identification information (col. 6, lines 35-45).

17. For claims 9, 26, Emens teaches that said connection means sustains the connection between the targets and said user terminal as long as the imaging means is imaging the targets or their identification information (col. 5, lines 20-25).

18. For claims 11, 27, Emens teaches that said connection means sustains the connection between the targets and said user terminal as long as the targets identified by said identification means are displayed on said display screen (Fig. 2G in view of Fig. 2H).

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19. For claims 12, 28, Emens teaches that said images of the targets taken by said imaging means is held on said display screen as long as said connection means sustains the connection between the targets and said user terminal (col. 5, lines 20-25).

20. For claims 14, 29, 30, Emens teaches that said user terminal has a storage means for storing the taken images of said targets identified by said identification means, and said connection means establishes connection between said user terminal and relevant taken targets in response to the display of said image on said display screen (col. 5, lines 20-22).

21. For claims 18, 33, Emens teaches that said user terminal has a user input means (col. 6, line 5; cursor control device), and said application means transfers the user input data input by using said user input means as user input data on a computer system, or a target, as long as said connection means sustains the connection between the computer system and the user terminal (Fig. 3, #314 and #318).

22. For claims 19, 34, Emens teaches that said application means obtains the data to be shown from targets and displays them on the display screen as long as said connection means sustains the connection between said targets (Fig. 2H) including said data to be shown and updated regularly or irregularly and the user terminal (col. 6, lines 40-60).

23. For claims 21, 36, 38, 39, Emens teaches that said application means transmits the video recording appointment information input at said user terminal to a target, or a video recording/reproduction apparatus having a video recording appointment feature so long as said connection means sustains the connection between said video recording/reproduction apparatus and the user terminal (col. 5, lines 15-20).

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24. For claims 22, 37, Emens teaches that said application means displays an image of operation for controlling remotely controllable targets on the display screen and transmit the user operation displayed on the display screen to the targets as long as said connection means sustain the connection between the target and the user terminal (col. 6, lines 40-60).

25. Claims 20 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens and Kerchner as applied to claims 3 and 23 above, and further in view of Fowler et al. (6,714,977).

26. For claims 20, 35, Emens does not expressly disclose that said application means receives alarms from a target, or a device having an alarm feature, and execute said alarm on said user terminal as long as said connection means sustains the connection between the target and the user terminal. Fowler teaches a method (abstract) of providing remote control of network devices (col. 1, line 1 – col. 4, line 51) using imaging systems (col. 7, line 25 – col. 8, line 10) to connect and monitor devices (col. 8, lines 10-60), in which alarms execute on a user terminal (Fig. 17; col. 8, line 60 – col. 9, line 5). At the time the invention was made, one of ordinary skill in the art would have added Fowler alarms to Emens in order to handle device problems (col. 3, lines 5-15) and to provide room information to the user (col. 3, lines 20-40).

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They provide further information on automatically identifying a connection path, i.e. based on information transmitted from the target device, and on utilization of imaging means.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHP
12 June 2006

Melvin H. Pollack
AU 2145
